

REMARKS/ARGUMENTS

The rejections presented in the Office action dated November 16, 2010 (hereinafter Office action), have been considered. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant appreciates the indication of allowability for claims 32 and 34; however, Applicant respectfully declines the opportunity to amend these claims at this time.

With respect to the § 101 rejection of claims 21 and 27, the claims have been amended to indicate that the claimed computer readable media are non-transitory. Applicant notes that non-transitory computer readable media comprise all computer readable media, with the sole exception being a transitory, propagating signal. Since an interpretation of the claims is now limited to statutory subject matter, Applicant submits that the rejection has been overcome and accordingly requests that the rejection be withdrawn.

Without acquiescing to characterizations of the asserted art, Applicant's claimed subject matter, or to the applications of the asserted art or combinations thereof to Applicant's claimed subject matter, and in an effort to place the application in condition for allowance, independent claims 1, 9, and 21 have been amended to characterize that the user interface is adjusted to an active or to an inactive state based on a state of a user interface component. Support for these changes may be found in the original specification, for example, at paragraphs [0031]-[0039]; therefore, these changes do not introduce new matter. None of the asserted references disclose adjusting a user interface state based on the state of a user interface component and preventing a handover algorithm based on the checking of the state of that user interface component and detecting that the user interface is inactive, as now claimed.

The asserted teachings do not teach or suggest each of the claimed features.

Applicant respectfully traverses each of the § 103(a) rejections based upon the teachings of Kubosawa as modified by those of Halonen, Lee, and McKinnon because the

asserted references alone, or in combination, fail to teach or suggest each of the claimed limitations. First, Kubosawa fails to correspond to several of the claimed features. For example, Kubosawa does not teach or suggest adjusting a user interface to an active or inactive state, or more particularly, adjusting on the basis of a state of a user interface component. Instead, the cited portion of Kubosawa discusses checking a specific key input (asserted as corresponding to the claimed checking the state of a user interface component). In contrast to the claimed adjustment of a state of a user interface to inactive state, in Kubosawa if no key input is detected, handover processing is continued (including judging further instructions from a user in step S9) by returning to step S3. There is no teaching or suggestion that detecting "NO INPUT" in step S9 would lead to adjusting a user interface of the terminal to an inactive state. Rather, Kubosawa suggests that the user interface would be active since the terminal is informing the user that handover cannot be executed as instructed using the LCD 66 (paragraph [0054]). Moreover, the Office action acknowledges that Kubosawa fails to teach or suggest preventing application of a handover algorithm.

In addition, Kubosawa would not teach or suggest enabling application of the handover algorithm in response to detecting the state of the user interface to change from the inactive to active state. Instead, Kubosawa teaches executing the inter-system handover in response to detecting in step S9 the user input and then ending the handover algorithm related procedure (or directly end the procedure in S12). In view of the above, Kubosawa's reliance on a user keying input to continue a handover procedure fails to correspond to the claimed prevention of a handover algorithm based on an inactive state of a user interface.

The reliance on Halonen fails to overcome the above-discussed deficiencies in Kubosawa. The cited portions of Halonen teach to stop execution of a time-limited handover algorithm by a time calculator (page 9, lines 19-21). There is no suggestion of preventing a handover algorithm based on a user interface state adjusted on the basis of the state of a user interface component. Thus, the asserted combination of Kubosawa and Halonen fails to disclose the current combination of features and would instead result in applying a time limitation to the handover procedure of Kubosawa.

With particular respect to the rejection of independent claim 35, none of the asserted references has been shown to teach or suggest at least initiating the handover algorithm in

response to detecting the state of the screen saver functionality to change from application of the screen saver functionality to the non-application of the screen saver functionality. Neither Kubosawa nor Halonen discusses the use of a screen saver functionality. McKinnon does not address screen saver monitoring with respect to a device that would perform handover and Lee could not use the screen saver monitoring disclosed by McKinnon since Lee's device is not operational prior to initiating handover. Since none of the asserted references teaches or suggests each of the claimed features, the rejection of at least claim 35 is improper. Applicant accordingly requests that the rejection be withdrawn.

Dependent claims 3, 8, 13, 19, 23-25, 27, 28, 31, and 33 depend from independent claims 1, 9, and 21, respectively, and each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the above-discussed combination of Kubosawa, Halonen, Lee, and McKinnon. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with the independent claims. These dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 3, 8, 13, 19, 23-25, 27, 28, 31, and 33 are also patentable over Kubosawa, Halonen, Lee, and McKinnon.

With particular respect to dependent claims 23, 25, and 27, Applicant further traverses because the cited portion of Kubosawa fails to teach or suggest the claimed limitations. The claims require that radio measurements are omitted in response to the current state of the user interface component being inactive. The assertion that Kubosawa would perform measurements if the user interface is active fails to correspond to the claimed opposite situation. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejection of at least these claims is improper.

With respect to the § 103(a) rejections of dependent claims 5, 6, 15-17, and 20 based upon Kubosawa, Halonen, and Lee as combined with Claxton, Cowsky, III *et al.*, and Harris *et al.*, respectively, Applicant respectfully traverses. As discussed above, the combination of Kubosawa, Halonen, Lee, and McKinnon fails to correspond to the limitations of independent claims 1 and 9 (from which claims 5, 6, 15-17, and 20 depend). The further reliance on these additional teachings does not overcome the above-discussed deficiencies in Kubosawa, Halonen, Lee, and McKinnon. Moreover, it has not been shown that Claxton teaches checking states of the features set forth in claims 5, 15, and 16, or that Cowsky describes checking of any locking feature. Thus, the asserted combinations of these teachings with the teachings of Kubosawa, Halonen, Lee, and McKinnon do not teach each of the claimed limitations of dependent claims 5, 6, 15-17, and 20, and each of the § 103(a) rejections should be withdrawn.

The asserted modifications would undermine the relied-upon teachings.

Each of the § 103(a) rejections are further traversed because the asserted modifications of Kubosawa would improperly change the principle of operation of the teachings of Kubosawa. If a proposed modification would change the principle operation of the prior art being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP § 2143.01(VI). The cited operations of Kubosawa illustrated in Fig. 2 are part of Kubosawa's handover operation/algorithm. Modifying Kubosawa to prevent the application of the handover algorithm would eliminate Kubosawa's performance of the cited operations. Kubosawa could not be modified to prevent application of the handover algorithm based on a lack of user input since the handover algorithm must already be applied before a determination regarding user input is made. The proposed modification to Kubosawa would change the principle operation of Kubosawa to preempt the handover procedure illustrated in Fig. 2 and eliminate the option to pursue handover when it is needed but not possible. A skilled artisan would not make such a change, and the asserted

modification fails to support the rejections. Applicant accordingly requests that the rejections be withdrawn.

Further the asserted modifications of Kubosawa and Halonen with the teachings of Lee would undermine the principle operations of Kubosawa and Halonen. The cited portions of Lee require a device to be “off” or not operational prior to initiating a handover algorithm. This would clearly undermine the teachings of Kubosawa and Halonen which require that a device be operational to perform the relied-upon features. Turning the devices of Kubosawa or Halonen off prior to initiating handover is illogical and a skilled artisan would not make such a modification. Applicant accordingly requests that the rejections be withdrawn.

It should be noted that Applicant does not acquiesce to the Examiner’s statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant’s invention, inherent, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner’s characterizations, conclusions, and rejections in future prosecution.

In addition, new claims 36-41 have been added. The subject matter of claims 36, 37, 39, and 40 has been removed from independent claims 1 and 9 and support for claims 38 and 41 may be found in the original specification, for example, at paragraph [0039]; therefore, none of these claims introduces new matter to the application. Each of these claims is believed to be patentable over the asserted references for the reasons set forth above in connection with the independent claims.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.083PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8500 Normandale Lake Blvd., Suite 320
Minneapolis, MN 55437
952.232.6907

Date: March 16, 2011

By: /Erin Nichols Matkaiti/

Erin Nichols Matkaiti
Reg. No. 57,125